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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,337	04/10/2006	Martin Weber	12810-00233-US1	7713
23416 7590 10/17/2008 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER KAHN, RACHEL				
ART UNIT 4131		PAPER NUMBER		
MAIL DATE 10/17/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,337

Applicant(s)

WEBER ET AL.

Examiner

RACHEL KAHN

Art Unit

4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 4/10/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 provides for the use of thermoplastic molding compositions, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 9, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (WO 01/64792) in view of Dorrestijn et al (EP 0784080). Weber discloses a molding compound comprising both a piperidine-capped polyamide (page 29, line 8) and an impact modification rubber (page 29, line 40). The piperidine-capped polyamide taught by Weber is identical to the polyamide A1 disclosed in instant claims 1 and 2. The recitations of instant claim 2 can be found on page 30, line 12. Weber fails to teach the copolymer disclosed in instant claim 1, part B.

Dorrestijn teaches: a rubber modified polymer composition comprising a thermoplastic polyamide, a rubber satisfying the recitation of instant claim 1C, and a third polymer which acts as a compatibility-enhancing agent (page 6, lines 24 to 39). Dorrestijn notes that polyamides are not miscible or compatible with rubber graft copolymers, and a compatibilizing agent is required to obtain a composition with useful properties (page 4, lines 8-11). The polymer disclosed in instant claim 1B is taught by Dorrestijn as a compatibilizing agent (page 6, lines 29-34).

Given the teachings of Dorrestijn that polyamides and rubbers are incompatible, it would be obvious to one of ordinary skill in the art to add the compatibility enhancing polymer disclosed by Dorrestijn when preparing a composition containing both the

piperidine-capped polyamide and rubber disclosed by Weber. The resulting composition would satisfy the recitations of instant claims 1 and 2.

The recitations of instant claim 9 can be found in Weber at page 31, lines 1-3, and also in the included Google translation of Weber's claims, page 3.

Instant claims 4 and 11 recite an additional component, which, in essence, is an equivalent of a polymer defined by instant claim 1B. Instant claims 5 and 13 recite an additional component which is an equivalent of a polymer defined by instant claim 1c. Instant claim 15 recites both an equivalent of instant claim 1B and 1c. Combining equivalents known for the same purpose has been held to establish *prima facie* obviousness (see MPEP 2144.06).

Claims 6, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (WO 01/64792) in view of Dorrestijn et al (EP 0784080) as applied to claims 1 and 2 above, and further in view of Guntherberg et al (US 6566436). Dorrestijn suggests the addition of additives to the polymer composition, including lubricants (page 4, line 43). The examples disclosed by Dorrestijn contain 1.1 wt% of "customary additives." Dorrestijn fails to specifically teach the use of silicone oil or stearate. If the selection of these compounds as lubricants is not considered obvious in view of Dorrestijn alone, Guntherberg teaches thermoplastic molding compositions containing lubricant additives, and specifically teaches the use of stearates (column 12, line 48) and silicone oils (column 12 line 54) as useful for producing moldings (column 12, line 29). It would be obvious to one of ordinary skill in the art to choose silicone oil or stearate as the lubricant suggested by Dorrestijn, especially in view of Guntherberg,

as they are commonly used in the art to produce desirable properties in thermoplastic compositions.

Instant claim 18 recites an additional component, which, in essence, is an equivalent of a polymer defined by instant claim 1B. Instant claim 19 recites an additional component which is an equivalent of a polymer defined by instant claim 1c. Combining equivalents known for the same purpose has been held to establish *prima facie* obviousness (see MPEP 2144.06).

Claims 1, 3, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilg et al (US 6867266) in view of Dorrestijn et al (EP 0784080). Ilg, like Weber above, discloses a thermoformable composition comprising a piperidine-capped polyamide (column 4, lines 1-20) and teaches that any thermoformable polymer, including ABS (a rubber copolymer) may be used in combination with the polyamide (column 7, line 30). Ilg fails to teach the use of polymer B in instant claim 1. This compatibility enhancing polymer is taught by Dorrestijn, and would be obvious to use, as discussed in the rejection of claims 1 and 2 above. The recitations of instant claim 3 are taught by Ilg in column 12, tables 1-3, as well as in column 14, lines 27-30.

Instant claim 12 recites an additional component, which, in essence, is an equivalent of a polymer defined by instant claim 1B. Instant claim 14 recites an additional component which is an equivalent of a polymer defined by instant claim 1c. Combining equivalents known for the same purpose has been held to establish *prima facie* obviousness (see MPEP 2144.06).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ilg et al (US 6867266) in view of Dorrestijn et al (EP 0784080) as applied to claims 1 and 3 above, and further in view of Guntherberg et al (US 6566436) as applied to claim 6 above.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (WO 01/64792) in view of Dorrestijn et al (EP 0784080) as applied to claims 1 and 2 above, and further in view of Ilg et al (US 6867266). Weber and Dorrestijn fail to teach that the polymer compositions can contain a mixture of polyamides both with and without a piperidine cap. As discussed above, Ilg, like Weber, discloses a piperidine-capped polyamide composition. Ilg discloses mixtures of polyamides with and without piperidine-caps in column 12, tables 1-3, as well as in column 14, lines 27--30. It would be obvious to one of ordinary skill in the art to use mixtures of polyamides when preparing the compositions disclosed by Weber and Dorrestijn because, as Ilg points out, the light stabilizing properties imparted by the piperidine caps are obtained at concentrations of less than 0.5 wt% (column 1, line 33). Ilg also notes that light stabilized polymers are in tight supply due to limited manufacturing capacities (column 1, line 43), so it would be advantageous and logical to use a small amount of light stabilized polymer mixed with uncapped/unstabilized polyamides.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (WO 01/64792) in view of Dorrestijn et al (EP 0784080) as applied to claims 1 and 9 above, and further in view of Fischer et al (US 6479617). Weber discloses moldings, films or fibers obtained from thermoplastic molding compositions (translation page 3),

but fails to suggest that these articles could be further made into vehicle interior components. Fischer teaches vehicle interiors made from moldings from polymeric materials (column 1 line 11). It would be obvious to one of ordinary skill in the art to use the polymer moldings taught by Weber and Dorrestijn in vehicle interiors, as vehicle interiors are generally made from thermoplastic polymeric material.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (WO 01/64792) in view of Dorrestijn et al (EP 0784080) as applied to claim 1 above, and further in view of Wicker et al (US 6218467). Dorrestijn discloses a method of preparing a thermoplastic molding composition containing a polyamide, a rubber copolymer and a compatibilizing polymer (page 5, lines 9-10). Dorrestijn fails to disclose the order of mixing recited in instant claim 7. Wicker et al discloses compositions containing polyamides, ABS rubber copolymers, and a polymethyl methacrylate (PMMA) compatibilizing polymer (column 2 lines 1-8). Like Dorrestijn, Wicker teaches that rubber copolymers and polyamides are incompatible and brittle when combined, thus necessitating the use of PMMA as a polymeric modifier (column 1, lines 58-61 and column 2 lines 23-26). Wicker discloses that when preparing said polymeric compositions, two components can be preblended followed by addition of the remaining component (column 5, lines 8-13). Given the similarities among the components and desired products between the instant application and Wicker, it would be obvious to one of ordinary skill in the art to prepare the polymer compositions of instant claim 1 by preblending two components as taught by Wicker.

Furthermore, instant claim 7 differs from the prior art (Weber and Dorrestijn) only in terms of the sequence of adding ingredients. Changes in sequence of adding ingredients have been held to be *prima facie* obvious (see MPEP 2144.04).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL KAHN whose telephone number is (571)270-7346. The examiner can normally be reached on Monday to Friday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RACHEL KAHN/
Examiner, Art Unit 4131

/David R. Sample/
Supervisory Patent Examiner
Art Unit 4131

RK